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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,934

08/27/2003

Stuart B. Smith

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4108

24283 7590 04/10/2007  
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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/648,934

**Applicant(s)**

SMITH, STUART B.

**Examiner**

Margaret G. Moore

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 to 8, 10 to 24 is/are pending in the application.
- 4a) Of the above claim(s) 10 to 17, 20 to 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 to 8, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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1. The amendment filed 1/22/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the definition of x, y and z on page 6. Applicant has changed the upper limit of x, y and z to 100 but this does not overcome the new matter objection. This is insufficient because the original disclosure provides *no* definition of x, y and z. Any addition to the specification will be new matter. The Examiner first noted this new matter in the office action dated 12/13/05.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claims 6 to 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Reference to a "silicone modified epoxy resin" is confusing since claim 1 does teach or refer to a silicone modified epoxy resin. The Examiner notes that this language was added in an effort to overcome the rejection in paragraph 4 of the previous office action.

For claims 6 and 7, the Examiner suggests 1) removing "of silicone modified epoxy resin" such that the claims read "said epoxy functional silicone is from about 4 to about 38 parts by weight, based on 100 parts by weight of the total polyol prepolymer chain extender, and said at least one amine..." and 2) changing "based on 100 parts by weight of the total polyol prepolymer chain extender" to "based on 100 parts by weight of the total amine".

In claim 8, the claim language appears to be incomplete. This refers to a combination of amines but only recites one component in the combination. In addition the formula is located two lines above reference thereto. Again, the basis for the weight of amine is unclear.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 5, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/10255, herein Herzig et al., for reasons of record.

This rejection relies on the rationale noted in previous office action and as such this will not be repeated. Applicant's traversal is not persuasive. It is again argued that the epoxy functional silicone in claim 1 is branched to which the Examiner will again note that the silicone in Herzig et al. is *not* limited to linear.

The various arguments starting with the word "if" found in applicant's response are not persuasive as it is not clear what these scenarios have to do with the instant claims. The Examiner simply cannot find any relevance between these arguments and the instant claims. Applicant appears to be making unsupported assumptions about the reactions in Herzig et al. Perhaps applicant is reading more into the claims than there actually is. Note for instance that the branched epoxy functional silicone in the claims can have epoxy groups present only on the terminal ends of the siloxane backbone. In fact, there can be as little as one epoxy group in the epoxy functional silicone reactant. Also, there is nothing that requires the prepolymer to be liquid or excludes a gel. Note too that there is no degree of branching claimed. The silicone in the claims can have as little as one "T" unit.

On the other hand the Examiner also believes that applicant is reading limitations into Herzig et al. that are not present. Herzig prefer alpha omega diepoxy siloxanes but is not limited to such siloxanes. This reference does, however, prefer a molar excess of amine.

On line 6 of page 13 of applicant's remarks applicant refers to "steps to create a liquid polyurea". Applicant is reminded that it is not a liquid polyurea that is claimed.

It appears that applicant's arguments are consistent with those supplied in the response dated 6/16/06. As such the Examiner refers to her remarks in the office action dated 7/18/06 as they apply.

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5. Claims 1, 2, 4, 5, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raleigh et al. for reasons of record.

Applicant correctly notes that Raleigh et al. do not teach the invention but fail to argue why the requirement of a molar excess amine would have been unobvious. The Examiner gave a basis for the obviousness of this limitation that applicant has not addressed. As such this rejection is maintained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

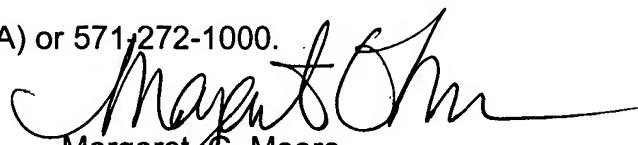
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
4/9/07